



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,151	12/09/2005	David F. Lawson	P02055US2A	9511
7590 05/30/2008 Bridgestone Americas Holding Inc Chief Intellectual Property Counsel 1200 Firestone Parkway Akron, OH 44317-0001				
EXAMINER				
RABAGO, ROBERTO				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
05/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,151

Applicant(s)

LAWSON ET AL.

Examiner

Roberto Rábago

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-13, 17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-13, 17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because in the line second from the end, "and" should be -
- or -- for proper Markush format.

Claim Rejections - 35 USC § 112

2. Claims 1-4, 8-13, 17, 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1 (and claims 2-4, 8, 9 and 20 as dependent thereon), no disclosure can be found of any of the compounds of (ii) beginning with triethoxysilyl and ending with disilacyclopentane as being epoxy-generating reagents. The same issue exists in claim 10 (and claims 11, 12, 13, 17 and 21 as dependent thereon).

Applicant's arguments filed 2/11/2008 have been fully considered but they are not persuasive. Contrary to applicants' argument, paragraph 46 provides no description of the epoxy-generating reagents cited above.

3. Claims 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, and claims 20-22 as dependent thereon, the meaning of a "highly" aromatic group is not understood. A functional group is either aromatic or it is not, and the intended meaning of applicant's apparent attempt to qualify the degree of aromaticity cannot be determined.

Double Patenting

4. Claim 19 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 9 and 10 of copending Application No. 10/579,954. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim is broader, and therefore anticipated by the copending claims. The copending claims recite a sequentially functionalized polymer comprising a first stage to incorporate a cyclic siloxane, and a second stage to incorporate an amine functionality; these groups are within the broad scope of groups specified in the instant claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 19 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-32 of copending Application No.

11/507,692. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim is broader, and therefore anticipated by the copending claims. Copending claim 10 recites a sequentially functionalized polymer comprising a first stage to incorporate a functionalized epoxide, and a second stage to incorporate an amine functionality; these groups are within the broad scope of groups specified in the instant claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Ozawa et al. (WO 03/046020). The US application filed under 35 USC 371 will be discussed for the benefit of its English language disclosure (US 2005/0070672).

The reference discloses in at least preparation Example 13 a sequentially functionalized polymer comprising a first stage to incorporate a functionalized epoxide, and a second stage to incorporate an imine functionality; these groups are within the broad scope of groups specified in the instant claim.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/
Primary Examiner
Art Unit 1796

RR
May 23, 2008